

REMARKS

INTRODUCTION

In view of the following remarks, reconsideration of the allowability of the claims is respectfully requested.

Claims 1-18 are pending in the subject application.

REJECTION UNDER 35 USC 103

Claims 1-3, 10 and 16-18 stand rejected under 35 USC § 103 as being obvious over Ravdin et al., U.S. Patent No. 5,862,304, in view of Smyth, U.S. Patent No. 5,465,321, and claims 4-9 and 11-15 stand rejected under 35 USC § 103 as being obvious over Ravdin et al. and Smyth, in view of Abrams et al., U.S. Patent No. 6,117,066. These rejections are respectfully traversed.

Although applicant disagrees with the Examiner's obviousness conclusion, the following remarks are primarily directed toward the Examiner's legal conclusions that interpretations of the particular claimed features should not be considered since they are not recited, or incorporated by reference, in the present specification. The previous remarks from the Response filed September 10, 2003, regarding the non-obviousness of the proffered combination are incorporated herein by reference, and applicant maintains support of the same.

In addition, as the underlying rejections are based on an incorrect interpretation/definition of "information flow," the underlying rejections fail to support prima facie obviousness cases.

"INFORMATION FLOW"

As previously pointed out, the claimed features must be given the "broadest "reasonable" interpretation afforded by one of ordinary skill in the art when read in light of the specification. In addition, the claims should be interpreted in light of their *plain meaning* as understood by one of ordinary skill in the art.

As recited in the Advisory Action: "[t]he Applicant correctly states that two articles by the Applicant are noted in the specification (paragraph 0002). The Applicant correctly states that these two articles were submitted in an IDS (Paper No. 3). The applicant asserts because the articles are noted in the specification, the articles are submitted in and IDS, and the correlation of the information in the articles is linked to the specification during prosecution, the definition of

information flow in the articles defines information flow for the Applicant's invention. The Examiner disagrees. The two articles noted in the specification were not incorporated by reference...The definition of information flow for the instant application is limited to the definition in the original specification."

It is respectfully submitted that this conclusion is contrary to current Federal Circuit decisions, which both Applicant and Examiner are required to abide by.

"It is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action," in addition, "an agency is not free to refuse to follow circuit precedent." In re Lee 61 USPQ2d 1430, 1434 (CA FC 2002).

As pointed out in In re Lee, the Examiner and Applicant are both bound by decisions of the Federal Circuit, and for an Office Action rejection to be proper and meet a prima facie standard the Office Action and rejection must abide with the decisions of the Federal Circuit, as well as not make conclusions, decisions, or interpretations in the Office Action contrary to such decisions of the Federal Circuit.

First, it is note that the previous reference to the previously filed IDS, was merely to point out to the Examiner where the references can easily be found. The filing of an IDS does not by itself mandate incorporation of the same into the claims or specification. Rather, as submitted herein, the ready availability, the reference in the specification, and link presented during prosecution reinforce the argument that the proffered definition/interpretation must be considered, regardless of the lack of an "incorporation by reference" recitation in the specification.

Secondly, the following Federal Circuit precedent is respectfully pointed out, noting that the same is binding in the present case.

Honeywell Inc. v. Victor Co. of Japan Ltd., 63 USPQ2d 1904 (CA FC 2002) "The district court erred in not according more weight to the inventor's definition. It is well settled that a patentee may define a claim term either in the written description of the patent or, as in the present case, in the prosecution history. Mycogen Plant Science v. Monsanto Co., 243 F.3d 1316, 1327, 58 USPQ2d 1030, 1039 (Fed. Cir. 2001). Frequently, a definition offered during prosecution is made in response to a rejection, and is entered in conjunction with a

narrowing amendment. See, e.g., Southwall Techs., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1677 (Fed. Cir. 1995). Such a definition limits the scope of the claim, preventing the patentee from later recapturing what was previously surrendered.

Although the inventor's definition does not have a narrowing effect, it is nonetheless relevant in indicating the meaning that the inventor ascribed to the term. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996) ('[T]he record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims.');

E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1438, 7 USPQ2d 1129, 1135 (Fed. Cir. 1988) (**prosecution history 'must be examined to ascertain the true meaning of what the inventor intended to convey in the claims'**)

Honeywell Inc. v. Victor Co. of Japan Ltd., 63 USPQ2d 1904 (CA FC 2002).

The Advisory Action briefly comments that because these references are not incorporated by reference, they will not be used to interpret the claimed "information flow." However, as noted above, the previous responses particularly linked the definition of "information flow" in the present application with these references, and such a link must be considered.

Specifically, again the Advisory Action language recites: "[t]he applicant asserts because the articles are noted in the specification, the articles are submitted in and IDS, and the correlation of the information in the articles is linked to the specification during prosecution, the definition of information flow in the articles defines information flow for the Applicant's invention. The Examiner disagrees."

However, as specifically pointed out above, since applicant asserted that the articles are noted in the specification, and because the Examiner has access to the same, and correlation of the definitions/interpretations in the articles has been linked to the specification during prosecution, such a definition/interpretation must be used.

By linking the definition/interpretation of information flow with these articles, the same narrowing definition is incorporated into the claims, and the broad interpretation used in rejecting the claims would be improper. In addition/accordance to/with the definition/interpretation in these references, as pointed out in the previous response, the claimed "information flow" is at least a characterization of a dynamic behavior (including statistical dependencies between past and future points in time) of a complex system. Neither Ravdin et al. nor Smyth disclose such a claimed information flow, and as the outstanding rejections rely on a contrary interpretation of

"information flow," compared to that defined in the present application, the outstanding rejections fail to set forth prima facie obviousness cases.

CONCLUSION

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: January 2, 2004

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